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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,385	04/15/2004	Yoshinori Ishizawa	20402-00621-US1	6629

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CONNOLLY BOVE LODGE & HUTZ LLP
SUITE 800
1990 M STREET NW
WASHINGTON, DC 20036-3425

EXAMINER

TRUONG, THANH K

ART UNIT PAPER NUMBER

3721

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,385

Applicant(s)

ISHIZAWA ET AL.

Examiner

Thanh K Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-40 is/are rejected.
- 7) ☒ Claim(s) 36,37,39 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4-15-04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: different parts have the same reference number: "nose 41 (page 14, line 26) and "injection hole 41" (page 14, line 31).

Appropriate correction is required.

Claim Objections

2. Claims 36, 37, 39 and 40 are objected to because of the following informalities: claims 36 and 37 depend on canceled claim 1, and similarly, claims 39 and 40 depend on canceled claim 4. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 35-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the other" (claim 35, line 13 and claim 38, line 13) is vague and indefinite, because it is unclear what the Applicant's is referring to as "the other". Moreover, the recitation in claim 38, lines 13-14, "combined grooves and ridges ... said valve piston" is confusing, because it is unclear what is the claim limitation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkins (3,568,909) in view of Fa et al. (5,785,228).

Perkins discloses a pneumatic tool comprising: a circular cylinder 13, a piston 14, a driver blade 17, a sleeve valve (where the portion of member 53 and the O-ring 38 make contact), an accumulator chamber 39 and a trigger valve portion (figures 2, 2A and 3).

Perkins discloses the claimed invention, but does not expressly disclose the trigger valve portion as recited in claims 35 and 38.

Fa discloses a pneumatic tool comprising a trigger valve portion 9, the trigger valve portion 9 further comprising:

a plunger 18 shifting in response to a trigger operation by a user;

a valve piston 34 having a surface allowing a slide movement relative to the plunger and shifting in a direction opposed to a shifting direction of the plunger; and

a valve bush 30, 31 having a surface slidably supporting the plunger and the valve piston so as to allow slide movements of the plunger and the valve piston; and

a seal member 51-53, 56, 57 provided on one of the valve piston and the plunger causing a slide movement relative to the valve piston; and

combined grooves and ridges formed on the valve piston and the plunger (grooves and ridges that hold the seal members 51-53, 56, 57).

Fa further discloses that the ridges cooperatively define an effective diameter (of the plunger and valve piston) of a guide along which the seal member is guided, and the grooves define an effective area of a relief passage of the compression air (figures 10 and 12 show seal members 57 and 51 effectively seal area of relief passage of compressed air). Fa's trigger valve portion would provide a multiple operation or function tool which provides the convenience of repeated actuations by trigger pull when the tool is held against a surface (column 2, lines 7-10).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Perkins' apparatus by incorporate the trigger valve portion as taught by Fa to provide an improved pneumatic hand tool.

The modified of Perkins' reference further discloses (figures 2, 2A, 3 and 4) the grooves (portions between the ridges 46) and ridges 46 are arranged alternately and extend in an axial direction of the plunger 43 (as in claims 37 and 40).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K Truong whose telephone number is (703) 605-0423. The examiner can normally be reached on Mon-Thurs from 8:00 AM to 6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tkr
August 25, 2004.

A handwritten signature in black ink, appearing to read 'Rinaldi I. Rada', with a long horizontal line extending to the right.

Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700